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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,551	10/14/2003	Steffen Wuensch	2775	9138

7590 09/22/2005

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EXAMINER

MULLER, BRYAN R

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,551

Applicant(s)

WUENSCH, STEFFEN

Examiner

Bryan R. Muller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **entire** side surface having a concave contour (the drawings show that at least a portion, specifically at points 111 and 121 of figure 6c have convex surface areas on the side surface) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term, "pagoda-shaped" is unclear, the word pagoda is defined as: A religious building of the Far East, especially a many-storied Buddhist tower, erected as a memorial or shrine or a structure, such as a garden pavilion, built in imitation of a many-storied Buddhist tower.¹ The definition does not define any type of shape that supports a "pagoda-shaped" object. Please define the shape in other terms without adding new matter. For the sake of the immediate action, the examiner will define "pagoda-shaped" as the shape shown in the drawings.

3. Claims 1 and 11 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not disclosed in the application or shown in the drawings that the **entire** side surface has a concave contour. The drawings clearly show convex contours on the side surface where the side surface meets the upper and lower surfaces (111 and 112) and fails to show any embodiment that has an entire side surface with a concave contour. Although this amendment was discussed

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during the interview, it is the duty of the applicant to ensure that no new matter is introduced with any amendments to the specification or claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Catalfamo (US Pub 2002/0197940) in view of Schadoffsky et al (6,443,825).

6. In reference to claim 1, Catalfamo discloses a grinding plate for an electric hand grinder comprising a plate member (10) having an upper plate surface with an upper plate edge, a lower plate surface with a lower plate edge for placement of a grinding means (1) and extending at least partially beyond said upper plate edge, and a side surface extending from said upper plate edge to said lower plate edge, said entire side surface in a projecting region of said lower plate edge having a pagoda-shaped concave contour from said upper plate edge to said lower plate edge to form a grinding edge lip. However, Catalfamo fails to disclose that the grinding plate has great yielding ability. Schadoffsky discloses that it is old and well known in the art to provide a flexible jacket (plate) to a sanding pad to insure that the sanding pad adapts to the surface to be sanded (col. 1, lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the grinding plate (10) of

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Catalfamo with a great yielding ability to insure that the sanding pad adapts to the surface to be sanded, as taught by Schadoffsky.

7. In reference to claim 2, Catalfame discloses that one embodiment of the grinding plate may accommodate a rectangular sanding pad (Figure 5), thus it would further be obvious that the upper and lower surfaces of the grinding plate must have a rectangular shape, said lower plate surface extending beyond said upper plate surface at both long side and both short sides of the rectangle.

8. In reference to claim 3, Catalfamo further discloses that the upper and lower plate surfaces have a circular shape, said lower plate surface extending circumferentially beyond said upper plate surface.

9. In reference to claim 11, the claim appears to be a product by process claim. The obvious combination of Catalfamo and Schadoffsky discloses the grinding plate having great yielding ability, as discussed supra, and it would further be obvious that the plate must be composed of elastic material to have great yielding ability. In reference to the portion of the claim disclosing the process in which the grinding plate is formed, please refer to MPEP 2113 regarding product by process claims ("If the product in the product-by-process claim is the same or is obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process") and *In Re Thorpe*.

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10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Catalfamo (US Pub 2002/0197940) in view of Schadoffsky et al (6,443,825) as applied to claim 1 and further in view of Bergner et al (5,626,510).

13. The obvious combination of Catalfamo and Schadoffsky discloses the grinding plate having great yielding ability, as discussed supra, and discloses that other shapes of sanding discs can be used (Figure 5), but fails to specifically disclose that plate edges of said upper and lower plate surfaces are joined to a tip located on a central axis of said plate surface, and the lower plate surface extending all around beyond said upper plate surface. Bergner discloses a grinding plate for an electric hand grinder that is in the shape of a triangle and teaches that the shape allows the grinding disc to be used up to the outermost, edge-adjacent region of corners or grooves (col. 1, lines 21-29), which cannot be done using the round grinding plate of Catalfamo and Schadoffsky. Therefore, Bergner teaches that it is well known in the art that triangular grinding plates can be used on electric grinders so it would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Catalfamo's statement that other shapes may be used and Bergner's teaching that triangular grinding plates are known in the art and can be used to for grinding in corners and grooves, to make the grinding plate of Catalfamo triangular to allow the grinding disc to be used up to the outermost, edge-adjacent region of corners or grooves. Thus the grinding plate would have the plate edges of the upper and lower plate surfaces joined at a tip located on a central axis of the plate surface and the lower plate surface extending all around beyond the upper plate surface.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Marton (British patent 1532772) discloses a grinding plate for an electric hand grinder with a "pagoda-shaped" side surface, Fussel (DD 226823 A1) discloses a hand-held grinder with "pagoda-shaped" side surfaces, Enders (3,336,702), Hartman (2,830,411) and Keith, Jr. (3,938,283) all disclose grinding plates for electric hand grinders that are rectangular and Martin (6,165,060) discloses a grinding plate for an electric hand grinder with a tip located on a central axis of the plate surface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan R. Muller whose telephone number is (571) 272-4489. The examiner can normally be reached on Monday thru Thursday and second Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BRM *BRM*
9/16/2005



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